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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 701,011	11 22 2000	Hiroshi Ando	001550	4791

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

(1)

DATE MAILED: 01 22 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

Office Action Summary

Application No.

09701.011

Applicant(s)

ANDO ET AL

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other

Based on the Examiner's indication of allowable subject matter in claim 3. Applicant has combined the limitations of original claims 1 and 3 in creating a new base claim. After further consideration of the independent claim, it was determined that the Examiner had, perhaps, viewed the claims too narrowly hence a modified search of the prior art was initiated, the results of which are outlined below. The Examiner sincerely regrets any inconvenience to the Applicant.

Specification

Applicant has not yet amended the Specification at pages 13 and 14 to make the terminology used in the description consistent with that currently employed in claim 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 3, 4, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Proebster et al., U.S. Patent # 6,025,416. Proebster discloses a two-part adhesive composition comprising,

as part A:

a mixture of,

(i) an organosilicon-terminated polymer

(ii) filler,

(iii) plasticizers selected from phthalic acid esters, sulfonic acid esters, alkyl/aryl phosphates, and dialkyl esters of aliphatic dicarboxylic acids (column 3, lines 15-19),

(iv) coupling agents including, for example, 3-aminopropyltrialkoxysilane (column 3, lines 28-32),

(v) di- and tetravalent tin catalysts such as tin octanoate and tin naphthenate,

(vi) other conventional adjuvants; and

as part B:

(1) crosslinking agents or "accelerators" analogous to components

(iv) and (v) of part A and

(2) auxiliaries including thixotropic agents and surfactants.

The Examiner acknowledges their express mention of phthalic acid ester based plasticizers. Nonetheless, these represent only one of several classes of materials that may be employed as a plasticizer. Where part A comprises, instead, a phosphate compound or a dialkyl ester of an aliphatic dicarboxylic acid, the claims are anticipated.

Claims 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa et al., U.S. Patent # 5,541,266. They disclose a self-adhering sealant composition comprised of (a) 100 parts of a hydrolyzable silyl group-functionalized polyether, (b) 0.01 to 20 parts of an aminoalkyl-functionalized silane, (c) a condensation catalyst selected from any of the more traditional compounds including amines, titanium derivatives, Bronsted acids and bases, and tetra and divalent tin complexes e.g. tin octanoate and tin naphthenate. It is further contemplated that various fillers, plasticizers, and other additives will be incorporated as needed (column 4, lines 60-62). Among the plasticizers identified are phthalic esters, polyesters, polyethers, and polybutadiene homo- and copolymers. Where the plasticizer chosen is other than phthalic esters, the aforementioned claims are anticipated.

Allowable Subject Matter

Gasmena, U.S. Patent # 5,703,178 teaches a heat ablative composition that contains materials corresponding to (a), (c), (d), (f), and (g) of the instant invention. Gasmena even teaches formulating these materials as a two-component composition although the individual parts are different than those disclosed in claim 7. The

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reference further alludes to the incorporation of a plasticizer. However, no particular compounds are volunteered to serve as this component nor could the Examiner ascertain what would motivate one of ordinary skill to avoid the use of plasticizers derived from phthalic acid. Insofar as this reference is believed to constitute the most closely related art, claims 7-10 are allowable.

Katsuta, JP 2001-152092, teaches a composition having the same materials as those mentioned in claim 3 but its publication does not antedate the filing date of this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

January 14, 2003



Robert A. Dawson,
Senior Patent Examiner
Technology Center 1700